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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/216,206 12/18/98 KAY

H EWG-079

EXAMINER

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13314 VERMEER DRIVE  
LAKE OSWEGO OR 97035

LM01/0412

MYHRE, J

ART UNIT  PAPER NUMBER

2767

**DATE MAILED:**

04/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/216,206</b>	Applicant(s) <b>KAY et al</b>
	Examiner <b>James Myhre</b>	Group Art Unit <b>2767</b>
		

Responsive to communication(s) filed on Dec 18, 1998.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-13 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson (5,974,398) in view of Gerace (5,991,735).

Claims 1, 4, 5, and 11: Hanson discloses a system and method for presenting advertisements online comprising:

- a. Storing advertisements on a web server (col 5, lines 48-50);
- b. Supplying selection criteria for view-ops (accessing web site)(col 3, lines 50-56);
- c. Calculating and selecting advertisements with matching criteria (col 5, lines 3-10); and
- d. Basing the selection on the historical results of displaying the advertisement on the web site (col 4, line 61 - col 5, line 2).

While Hanson discloses a historical database which is used to record and track the usage of the site by various customers and for adjusting the advertiser's subsequent bid amounts, Hanson does not explicitly disclose that the calculations take into account the effectiveness of displaying the advertisement on the site. Gerace discloses a similar system and method for

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determining a behavioral profile of a computer user in which the advertisement cost is based upon the number of times the advertisement was displayed, the number of hits received, and number of subsequent purchases made by customers (col 3, lines 18-26, col 4, lines 54-61, and col 5, lines 54-67). It is also well known within the marketing art to increase or decrease the amount of marketing funds spent on an advertising media based on the effectiveness of that media. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include this information as part of the criteria used by Hanson to select the advertisement. One would have been motivated to include the historical data of the site in order to increase the effectiveness of the marketing funds spent.

Claim 2: Hanson and Gerace disclose the system and method for presenting advertisements online as in Claim 1 above. Both references further disclose scheduling the matching advertisements (Hanson, col. 7, lines 5-21)(Gerace, col 15, lines 21-33).

Claims 3, 8, 9, and 10: Hanson and Gerace disclose the system and method for presenting advertisements online as in Claim 2 above. Gerace further discloses performing the calculation for each view-op after an initialization/evaluation period (col 4, lines 44-61; col 14, lines 17-45; and col 17, lines 22-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include an initialization/evaluation period for new users of Hanson's system. One would have been motivated to include an initialization/evaluation period in order to allow "sponsors to better direct their advertisements and enables advertisements to be tailored to target users' display preferences" as stated by Gerace (col 4, lines 59-61).

Claim 6: Hanson and Gerace disclose a system and method for presenting advertisements online as in Claim 4 above. Hanson further discloses selecting, scheduling, and displaying the highest bids (col 5, lines 38-42 and col 8, lines 1-10).

Claim 7: Hanson and Gerace disclose a system and method for presenting advertisements online as in Claim 6 above. Gerace further discloses using regressive techniques for calculating the performance of the advertisements (col 5, lines 54-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include past, present, and projected future performance data of each advertisements to the sponsor in the Hanson system. One would have been motivated to include all types of performance data in order to enable the sponsor to make better marketing decisions in regards to the type of advertisement and the level of the corresponding bid.

Claims 12 and 13: Hanson and Gerace disclose a system and method for presenting advertisements online as in Claims 1 and 4 above. Both references further disclose that the bids upon which the selection is based are monetary bids (Hanson, col 5, lines 39-42)(Gerace, col 12, lines 30-50).

### *Conclusion*

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- a. Dedrick (5,724,521) discloses a method and apparatus for presenting advertisements online in which the advertiser presents bids and the advertisement selection is based on the bid and on the user's preference profile. This reference could be used in support of a 35 U.S.C. 103 rejection of Claims 1, 2, 4-8, 10, 12, and 13.
- b. Christensen (6,035,280) discloses a method and apparatus for generating electronic (Virtual) coupons targeted to specific users.
- c. Coffey (5,675,510) discloses a system for measuring the actions of a computer user and for predicting the user's future actions.
- d. Reiter (5,819,241) discloses a system for presenting customized advertisements to users.
- e. Marsh et al (5,848,397) discloses a method and apparatus for scheduling the presentation of advertisements to users which tracks and logs statistical information, updates the scheduling criteria, and presenting performance statistics to the sponsor.
- f. Goldhaber et al (5,855,008) discloses a system for distributing advertisements over a computer network with the sponsors buying and selling the attention of the consumers, and which also maintains consumer profiles.
- g. Goldhaber et al (5,794,210) discloses a system for distributing advertisements over a computer network with the sponsors buying and selling the attention of the consumers, and which also maintains consumer profiles.

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h. Roden (5,970,477) discloses a system and method for allocating the cost of a distributed computer network by spreading the cost between the user and advertisement sponsors.

i. Allard et al (6,018,619) discloses a system, method, and apparatus for tracking the usage of information servers. This reference could be used in support of a 35 U.S.C. 103 rejection of Claims 1, 2, 4, 5, and 11.

j. Clement (5,684,963) discloses a system and method for tracking the distribution of video data from a plurality of online sites.

k. Reilly et al (5,740,549) discloses a system and method for distributing advertisements online during computer idle time and which selects the advertisements based on the subscriber's profile.

l. Fujisaki (4,789,928) discloses a system for auctioning information which receives bids and updated bids from a plurality of members.

m. Bado et al (4,703,423) discloses a method and apparatus for generating advertisements based on a combination of sponsor and consumer input.

n. Bixler et al (5,745,882) discloses a method for searching for and displaying advertisements which match the user's criteria.

o. Dedrick (5,710,884) discloses a method and apparatus for presenting advertisements online in which the advertiser presents bids and the advertisement selection is based on the bid and on the user's preference profile. This reference could be used in support of a 35 U.S.C. 103 rejection of Claims 1, 2, 4-8, 10, 12, and 13.

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p. Weinblatt (5,515,270) discloses a technique for correlating the purchasing behavior of customers to advertisements and for presenting the collected data to the sponsors. This reference could be used in support of a 35 U.S.C. 103 rejection of Claims 2, 5, 6, and 11.

q. Saxe (5,636,346) discloses a system and method for targeting advertisements based on consumer profiles.

r. Cragun et al (5,774,868) discloses a system and method for automatically selecting and presenting promotional material (advertisements) based on recent customer purchases. This reference could be used in support of a 35 U.S.C. 103 rejection of Claims 2, 3, and 8-11.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann, can be reached on (703) 308-7791. The fax phone number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-3900.

  
WM  
April 7, 2000

  
TOD R. SWANN  
SUPERVISORY PATENT EXAMINER  
GROUP 2700